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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,270	06/09/2000	Kenneth Shepard	AP32158-070050.1280	2448
21003	7590	06/15/2005	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SHARON, AYAL I	
			ART UNIT	PAPER NUMBER

2123

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Interview Summary

**Application No.**

09/591,270

**Applicant(s)**

SHEPARD, KENNETH

**Examiner**

Ayal I. Sharon

**Art Unit**

2123

All participants (applicant, applicant's representative, PTO personnel):

(1) Ayal I. Sharon (Examiner).

(3) \_\_\_\_\_.

(2) Paul Ackerman (Applicant's Representative).

(4) \_\_\_\_\_.

Date of Interview: 03 June 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: N/A.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Ayal Sharon  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

## **INTERVIEW SUMMARY**

### ***Introduction***

1. Examiner initiated a telephone conversation with Applicant's Representative, Mr. Paul Ackerman (Reg. No. 39,891) on 6/3/2005 regarding U.S. Application 09/591,270, in the hopes of advancing the prosecution.

### ***Re: Provisional Application***

2. One problem that was raised by the Examiner was the date of the "Exhibit B" that accompanied the Rule 131 Affidavit that was submitted on 12/8/2003. This exhibit is a slide show, and the Affidavit states that the time stamp of the presentation is February 8, 1999. No date was given for the presentation itself.
3. Examiner stated that due to the filing date of the non-provisional application (6/9/2000), this would place the presentation more than 12 months before the filing date of the instant application, thereby falling under 35 U.S.C. §102(b).
4. Applicant's Representative pointed out that the application, as stated in the oath, claims priority to provisional application 60/138,842 filed on 6/10/1999. This eliminates the possibility of the slide show presentation falling under 35 U.S.C. §102(b).
5. Examiner stated that he would try to have the PALM data changed to reflect this, but noted that a Petition to Correct the Filing Receipt may be necessary, and that

an amendment to the first paragraph of the specification to include this info may also be necessary.

***Re: Supplemental Declaration to 37 C.F.R. §1.131 Affidavit***

6. The Supplemental Declaration to 37 C.F.R. §1.131 Affidavit, dated 2/3/2005, recites the limitations of claims 1 and 16, and subsequently (see paragraph 7) states that the ICCAD 99 paper "... constitutes proof of actual reduction to practice of the inventions of claims 1 and 16 prior to April 9, 1999.
7. As per MPEP §§ 715.07 and 2138.04 - 2138.06, the affidavit must recite sufficient facts for the Examiner to determine which of the claim limitations are satisfied by the exhibit. Therefore, the claim limitations should be mapped to teachings in the exhibit.

***Re: Inventorship***

8. In the Examiner's 37 C.F.R. §1.105 Requirement for Information dated 2/24/2004, paragraphs 3(f) and 3(g) concerned an IBM grant, and IBM's possible rights to the invention.
9. In the response dated 6/28/2004, the Applicant provided an "Exhibit A", a published IEEE article titled "Body-voltage estimation in digital PD-SOI circuits and its application to static timing analysis."
10. In the response, the Applicant refers to the final paragraph of this article which recites an acknowledgement of "a gift from the IBM Corporation under the

University Partnership Program". Applicant argues in the Response to the §1.105 that this gift program "disallows" IBM from patent ownership rights.

11. Examiner accepts Applicant's arguments regarding issues (f) and (g), however, Applicant's response raises a new issue. While the cited paragraph refers to a "gift ... under the University Partnership Program", it also "... gratefully acknowledge[s] C. T. Chuang, R. Puri, G. Sai-Halasz, and M. R. Rosenfeld of IBM Yorktown for encouragement, helpful discussions, and preprints of their work."
12. In addition, Mr. C. T. Chuang is also a co-author of references [1], [2], [4], [5], and [6] in the list of references in the cited article.
13. Moreover, Mr. C. T. Chuang is also a co-author of the 35 U.S.C. 102(e) prior art used to reject the claims in this application.
14. Applicants are requested to clarify Mr. Chuang's role in the claimed invention.

### ***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (571) 272-3714. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached at (571) 272-3749.

Any response to this office action should be faxed to (703) 872-9306,

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or mailed to:

USPTO  
P.O. Box 1450  
Alexandria, VA 22313-1450

or hand carried to:

USPTO  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 Receptionist, whose telephone number is (571) 272-2100.

Ayal I. Sharon

Art Unit 2123

June 3, 2005

*CMP*  
*W. T. House*  
*A.U. 2123*  
*TC 2100*  
*Bonney Graham*